

Amendments to the Drawings

Applicants request to amend the drawings currently pending in the Application by substituting the one replacement drawing sheet enclosed herewith, containing Figure 1, for the drawing sheets currently pending.

Figure 1 has been corrected to remove the extraneous word "therefore" in the box labeled "Communication Port" (28). No new matter will be added as a result of this substitution. Permission to amend the drawings by substitution is respectfully requested.

REMARKS

Claims 1-10 have been amended herein. Claims 12-20 have been added. Claims 1-20 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Support for the amendments and the new claims is found in the original claims and Specification.

Rejections Pursuant To 35 U.S.C. § 112, Second Paragraph

In the Action, claims 1-11 were rejected pursuant to 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejections are respectfully traversed.

The Action asserted that in claim 1 the "enabling . . ." phrase makes the claim indefinite and unclear and additionally is vague. The Action also asserted that in claim 9, the phrase "at least some . . ." renders the claim vague and indefinite. Applicants disagree.

However, even though the claims as originally presented are believed to satisfy the statutory mandate, the claims have been amended to even more clearly delineate the claimed invention.

The amendments presented herein are clarifications and do not limit the scope of the claims from those originally presented. It is respectfully submitted that all the pending claims are sufficiently definite and that the rejection pursuant to 35 U.S.C. § 112, second paragraph should be withdrawn.

Rejections Pursuant To 35 U.S.C. § 101

In the Action, claims 1-11 were rejected pursuant to 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. These rejections are respectfully traversed.

The Action asserted that with respect to claims 1-3, Applicants' element/step (c) represents nonfunctional descriptive material that cannot exhibit any function interrelationships with the way in which computing processes are performed. Applicants respectfully submit that the rejection is not clear. Step (c) of claim 1 is directed to the step of "producing at least one card . . .". Whether or not such a step would involve a computer, the production of a physical object such as a card is a physical process step and is therefore statutory subject matter under 35 U.S.C. § 101. The Action's reliance on MPEP § 2106 IV B 1(b) is not understood by the Applicants. By the Examiner's own acknowledgment, MPEP § 2106 IV B 1(b) requires the Examiner to **review the claim as a whole** to see whether or not **any** descriptive material is being recited. Applicants submit that the Examiner has not reviewed the claim as a whole in accordance with MPEP § 2106 IV B 1(b). For example, the following phrases in claim 1 clearly recites steps which cause physical activity or a function to be carried out by a device and do not merely define a human mental process:

"producing a plurality of digital certificates . . .";

"producing at least one card for each of the individual customers . . .";

"associating through operation of at least one computer the accounts of the individual customers with the digital certificates . . .";

"sending the cards . . ."; and

"digitally signing an electronic document through operation of one of a plurality of automated transaction machines . . ."

Thus the claim **as a whole** clearly recites statutory subject matter and the rejection under 35 U.S.C. § 101 is not proper and should be withdrawn.

In supporting the rejection, the Action argues that "applicant's described marking or indicia visible to human is not explicitly recited as being altered or impacted by any other element/step in the claim . . ." The Action also asserts that the recited indicia in step (c) is nonfunctional descriptive material that will not distinguish the claimed invention from the prior art in terms of patentability *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994). Applicants disagree.

Claim 1 originally recited "wherein each card includes a first visible indicia thereon." This feature clearly recited features regarding the physical characteristics of the card. The following phrase originally recited in the claim: "which corresponds to a source indicator mark for a digital signature service," further defines physical characteristics of the card and the visible indicia, and distinguishes the claimed invention from the prior art.

However, in an effort to make the claim even clearer, Applicants have grammatically amended claim 1 to recite this feature in the form of a compound adjective which modifies the noun "indicia" as follows: wherein each card includes a first visible **digital signature service source indicator mark** indicia thereon. Examples of digital signature service source indicator mark indicia (57) on an automated transaction machine and a card are shown in Figures 2 and 16

and are described in the Specification at paragraph [0103]. This amendment is a clarification and does not change the scope of the claim.

With respect to the cited cases of *In re Gulack* and *In re Lowry*, these cases do not support the Action's basis for rejecting the claims under 35 U.S.C. § 101, according a nonfunctional status to the recited indicia nor asserting that such recited indicia cannot distinguish the claimed invention in terms of patentability.

In re Gulack is directed to the issue of whether printed matter can be sufficient to distinguish a claim in view of the prior art for purposes of overcoming 35 U.S.C. § 103(a) obviousness rejections. In this case the rejections were overturned and the printed matter was accorded patentable weight and was not obvious over the prior art.

Further *In re Gulack* stated that "Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under Section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portions of the mutilated claim to be unpatentable. The claim must be read as a whole." *Id.* at 403. In this case, the Court found that a functional relationship does exist between the printed matter and the substrate as recited in the claims of the application at issue. Further the Court stated that:

A function's relationship of the precise type found by the CCPA in *Miller* -- to size or type of substrate, or conveying information about the substrate -- is not required. What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not

dispositive of obviousness. Rather the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *Id.* at 404.

The Court further stated that the patentable differences between the claims at issue in *In re Gulack* and the prior art, resided in the particular sequence of digits and in the derivation of that sequence of digits. The prior art at issue in that case did not disclose or suggest these features of the printed matter and as a result the Court reversed the obviousness rejections. *Id.* at 405.

With respect to *In re Lowry*, the Court stated that a printed matter rejection under Section 103 stands on questionable legal and logical footing. *Id.* at 1034. Further, *In re Lowry* held that data structures stored in memory can be patentable subject matter. Therefore it is not clear how *In re Lowry* is relevant to the rejections in the present case. *Id.* at 1036.

As with *In re Gulack*, claim 1 of the present application recites a specific type of visible indicia on a structural substrate (e.g. it was a band in *In re Gulack* and in the present application it is a card as recited in claims 1-11) which distinguishes the recited invention from the cited art. Thus the recited indicia in claims 1-3 has patentable weight and cannot be ignored by the Office as a feature that distinguishes the claim from the prior art.

In addition, with respect to step (e) of claim 1, data corresponding to an account number included on the card is read by an automated transaction machine which communicates with a digital signature service. Thus the claim specifically recites a relationship between a card which includes a **digital signature service** source indicator mark indicia thereon and the automated transaction machine which is capable of reading the data on the card and communicating with a

digital signature service. As discussed in the Specification at paragraph [0103] such indicia on the card enables a user to more easily locate an automated transaction machine which is capable of using the card for purposes of digitally signing an electronic document.

The recited indicia included on a physical card is therefore functional, as is the relationship between the recited indicia and the capabilities of an automated transaction machine that reads the card. As will be discussed below the applied art does not disclose or suggest these features and therefore the pending claims which recite these features are non-obvious with respect to the applied art.

In re Gulack, does not support the Examiner's assertions that to qualify as patentable matter, indicia visible to a human must be explicitly recited as being "altered or impacted by any other element/step in the claim". Rather *In re Gulack* supports the position that visible indicia (e.g. printed digits on a band) having meaning only to the human mind can be functional and can be the sole difference which distinguishes a claim from the prior art.

Applicants' respectfully submit that the U.S.C. § 101 rejection is not valid and the assertions regarding the inability of the indicia recited in claims 1-3 to distinguish the claimed invention from the prior art, have no support in the cited case law and should be withdrawn.

The Pending Claims Are Not Obvious in View of the Applied Art

Claims 1-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Muftic, U.S. Patent No. 5,850,442.

These rejections are respectfully traversed.

**The Applied References Do Not Disclose or Suggest
the Features and Relationships Recited in Applicants' Claims**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

The Muftic Reference

Muftic is directed to a communication system which uses smart tokens, such as smart cards or PCMCIA cards, and a public key infrastructure for enabling secure electronic transaction to occur over an open network (Column 1, lines 18-22).

The Pending Claims Are Not Obvious Over Muftic

In the Action claims 1-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Muftic. These rejections are respectfully traversed. Applicants' response to these rejections is based on the Office's referenced interpretations of Muftic. Any change in the Office's interpretation of the reference shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

Claim 1

Claim 1 is an independent claim which is directed to a method. With respect to all of the steps recited in claim 1, the Action refers to Muftic Figures 6, 7, 20, and 22 and associated text; Column 5, line 36 to column 8, line 7; Column 12, lines 5-58; and Column 17, line 57 to Column 18, line 10. Applicants have reviewed these specific portions of Muftic and the remaining portions of Muftic. However, not all of the features, relationships, and steps recited in claim 1 are shown or suggested either in these portions of Muftic or anywhere else in Muftic.

Although Muftic discusses applying a digital signature to an offer (2210) (Figure 22; Column 17, lines 59-60) nowhere does Muftic explain how this is done.

Claim 1 recites a method by which an electronic document can be digitally signed at an automated transaction machine. Step (e) of pending claim 1 specifically recites that:

each automated transaction machine is adapted to cause the electronic document to be digitally signed responsive to communication with the digital signature service, wherein in signing the electronic document at the one machine the communication includes communicating an account number on a card read by the one automated transaction machine.

Nowhere does Muftic disclose or suggest digitally signing an electronic document **through communication with the digital signature service**. Further, nowhere does Muftic disclose or suggest communication with a digital signature service that includes an **account number read from a user's card by an automated transaction machine**.

In addition, although Muftic discusses use of smart cards or PCMCIA cards (Column 10, lines 29-31), nowhere does Muftic disclose or suggest what (if any) visible indicia are on the cards used with the Muftic system.

In contrast to Muftic, step (c) of claim 1 recites in part "producing at least one card for each of the individual customers, wherein each card includes first visible digital signature service source indicator mark indicia thereon corresponding to a digital signature service."

Nowhere does Muftic disclose or suggest producing cards which include **visible digital signature service source indicator mark indicia thereon**. As discussed in Applicants'

Specification at Paragraph [0103] such indicia may be a logo or trademark for a digital signature service. As recited in step (e) of claim 1, the automated transaction machine communicates the account data read from the card with the digital signature service for purposes of causing an electronic document to be digitally signed. Nowhere does Muftic disclose or suggest placing a trademark, logo, or any other source indicator mark of a digital signature service on a card. Further, nowhere does Muftic disclose or suggest a method in which a card with a digital signature service source indicator mark indicia thereon, is both produced for a customer and used by the customer at an automated transaction machine to cause an electronic document to be digitally signed through communication with a digital signature service.

These features are not inherent in Muftic. Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that the missing components are necessarily present in Muftic. To establish inherency the Office must prove through citation to prior art that the features alleged to be inherent are "necessarily present" in Muftic. For example, it is possible that in Muftic an offer could be digitally signed locally by a computer of Muftic without use of a card. Nowhere is there a teaching or suggestion in Muftic that computers that "apply digital signatures" require communication with a digital signature service and/or require cards that include visible digital signature service source indicator mark indicia thereon.

The Office has not proven through citation to prior art that the features alleged to be inherent are "necessarily present" in Muftic. Inherency may not be established based on probabilities or possibilities (which is the present situation). It is plainly improper to reject a claim based merely on the (speculative) possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

The Action asserts that ATMs bear multiple markings for financial areas such as Visa, Master Card, Amex, Plus, or Cirrus. The Action also asserts that "[s]ometime, when a user visits a web site and wants to conduct a purchase or any other transaction online such markings are provided to inform the user that they may use their credit cards such as MasterCard or Visa . . .". To the extent the Action attempts to claim "Official Notice" of such features, Applicants object. Such unsubstantiated assertions appear to have been provided to support the Action's assertion that it "would have been obvious to one having ordinary skill in the art at the time the current invention was made to place indicia indicating markings of the entity providing service to the user to make sure that the user is communicating with the appropriate certifying authority providing the service." Applicants disagree.

Nowhere does Muftic disclose or suggest that its smart cards or computer (Figure 3) include any such markings. Further nowhere does Muftic disclose or suggest using ATMs to carry out any of the functions described for the Muftic system. Also Muftic does not disclose or suggest that its system accesses web sites with such markings.

Even if the Action could show the prior art existence of credit card trademarks on a card, ATM, or web site (which it has not) such features would not by themselves or in combination with Muftic, disclose or suggest producing a card that includes a **visible digital signature service source indicator mark indicia thereon**. Nowhere has the Action shown where a card with any form of digital signature service source indicator exists in the prior art. Nor has Action provided any prior art teaching or suggestion to modify the cards in Muftic to include such indicia.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*,

supra. Applicants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

Applicants further respectfully submit that the Action has failed to show where the prior art also teaches or suggests at least the following as recited in claim 1:

producing a card that includes a **digital signature service source indicator mark**
indicia thereon;

operating an automated transaction machine to digitally sign a document displayed
through the automated transaction machine;

operating an automated transaction machine to cause an electronic document to be
digitally signed **responsive to communication with the digital signature service;** or

operating an automated transaction responsive to such communication with the digital
signature service where the **communication includes the account number read from**
the card by the automated transaction machine.

The Action's attempts to combine features of the cited reference of Muftic with the alleged teachings of ATMs and web sites for which the Action provides no prior art support, are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22

USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Applicants' disclosure.

As previously discussed, the prior art shown by the Office, does not disclose or suggest the features and relationships that are specifically recited in claim 1. Thus, a *prima facie* case of obviousness has not been established. Furthermore, as previously discussed, it would not have been obvious to one having ordinary skill in the art to have modified the applied reference as asserted in the Action. Therefore, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

The Dependent Claims

Each of the dependent claims 2-11 depends directly or indirectly from an independent claim. Independent claim 1 has been previously shown to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features, relationships, and/or steps that patentably distinguish the claimed invention over the applied art. Muftic does not disclose or suggest the additional features, relationships, and/or steps that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features, relationships, and/or steps.

Claim 2

Claim 2 depends from claim 1. Nowhere does Muftic disclose or suggest labeling an automated transaction machine with **visible digital signature service source indicator mark indicia**. Further nowhere does Muftic disclose or suggest reading a card at such a machine where the card and the machine both include **visible digital signature service source indicator mark indicia**. Thus, the Office has not established *prima facie* obviousness with respect to claim 2.

Claim 3

Claim 3 depends from claim 2. Nowhere does Muftic disclose or suggest labeling **visible digital signature service source indicator mark indicia on or adjacent a fascia of the automated transaction machines**. Further nowhere does Muftic disclose or suggest that a first visible digital signature service source indicator mark indicia included on a card, and a second visible digital signature service source indicator mark indicia on an automated transaction machine **are visually similar**. Thus, the Office has not established *prima facie* obviousness with respect to claim 3.

Claim 4

Claim 4 depends from claim 1. Nowhere does Muftic disclose or suggest communicating with a digital signature service to cause an electronic document displayed by the automated transaction machine to be digitally signed responsive to the private key that corresponds to the public key of the digital certificate which is associated with the account of the individual

customer using the machine. Thus, the Office has not established *prima facie* obviousness with respect to claim 4.

Claim 5

Claim 5 depends from claim 1. Nowhere does Muftic disclose or suggest a digital signature service that **is operative to access a private key associated with the account number read from the card**. Further nowhere does Muftic disclose or suggest a digital signature service that causes the electronic document to be digitally signed by an automated transaction machine responsive to the private key associated with the account number read from a card. Thus, the Office has not established *prima facie* obviousness with respect to claim 5.

Claim 6

Claim 6 depends from claim 1. Nowhere does Muftic disclose or suggest producing cards with a digital signature service source indicator mark indicia thereon, which are **financial account cards**. Thus, the Office has not established *prima facie* obviousness with respect to claim 6.

In addition the Action asserts without citing any prior art that "it would have been obvious to one having ordinary skill in the art at the time the current invention was made to interconnect the financial account information of a user to associate with certification authority of the public/private key management system of they might even be the same for the reason that it make it more controllable and as well as it would be beneficial to only use one card or smart token to conduct multiple transaction rather than having multiple cards associated with multiple

entities for conducting secure transaction." The Action further points to Paltenche, et al., U.S. Application Publication No. 2002/0004783 ("Paltenche").

Applicants disagree with these assertions. Paltenche was published January 10, 2002. The present application claims priority to U.S. provisional application nos. 60/273,996 filed March 7, 2001 and 60/319,015 filed November 29, 2001. Thus the Paltenche publication does not qualify as prior art and cannot be used as a basis to support the rejections in the Action.

Further, even if Paltenche could qualify as prior art, neither Paltenche nor Muftic alone or in combination support the assertions made in the Action. For example, neither reference discloses or suggests to "interconnect the financial account information of a user to associate with certification authority of the public/private key management system . . ." as asserted in the Action. Nowhere do these references disclose or suggest using a financial account number read from a card to locate a private key for purposes of signing an electronic document.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Applicants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

Further, the teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, supra.

The Office has not established *prima facie* obviousness with respect to claim 6.

Claim 7

Claim 7 depends from claim 6. The Action makes a number of unsupported assertions regarding processing fees associated with credit cards (Muftic, Column 14, lines 3-19) and financial transactions using ATMs of Bank of America and SunTrust.

The Action's assertions are not based on any evidence in the record. An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Applicants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

Further the teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, supra.

In addition, whether or not Muftic or the alleged ATMs of Bank of America and SunTrust disclose or suggest charging processing fees for credit card or banking transactions, such a teaching would still not provide evidence to support the rejection of claim 7.

Nowhere does Muftic or any other cited art, disclose or suggest causing processing fees to **be assessed for the digital signing of electronic documents**. In addition, nowhere does Muftic or any other cited art, disclose or suggest enabling **an entity that manages the financial account for an individual customer to receive at least a portion of the processing fees assessed for the digital signing of electronic documents**.

Thus, the Office has not established *prima facie* obviousness with respect to claim 7.

Claim 8

Claim 8 depends from claim 1. Nowhere does Muftic disclose or suggest that automated transaction machines **include digitizing signature pads**. Further nowhere does Muftic disclose or suggest that automated transaction machines are operative to associate handwritten signature data captured with the digitizing signature pads with the electronic documents.

The Action admits that Muftic does not disclose or suggest that automated transaction machines are operative to include handwritten signature data captured with the digitizing signature pads in the electronic documents. The Action's assertions regarding it being obvious to combine Muftic with devices for capturing handwritten signatures is not supported by the evidence of record.

Again an assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Applicants respectfully submit that because the rejection is based on mere assertions and not any prior art evidence of record, it is not a valid rejection.

Further the teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, supra.

The Office has not established *prima facie* obviousness with respect to claim 8.

Claim 9

Claim 9 depends from claim 1. Nowhere does Muftic disclose or suggest digitally signing an electronic document through operation of an automated transaction machine, where the automated transaction machine **includes a cash dispenser** that is operative to dispense cash. Column 4, lines 48-59 of Muftic clearly teaches away from using an ATM with the system described in Muftic. Thus there is no teaching, suggestion, or motivation in Muftic to use ATMs for purposes of digitally signing electronic documents. It is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 9 should be withdrawn.

Claim 10

Claim 10 depends from claim 9. Applicants' arguments with respect to claim 6 are incorporated by reference herein with respect to claim 10. Nowhere does Muftic disclose or suggest **bank cards which include a first visible digital signature service source indicator mark indicia thereon**. Further nowhere does Muftic disclose or suggest bank cards which include machine readable data corresponding to banking accounts, with first visible digital signature service source indicator mark indicia thereon. In addition nowhere does Muftic disclose or suggest that **automated transaction machines which include cash dispensers are operative to digitally sign an electronic document displayed by the automated transaction machine**. Also nowhere does Muftic disclose or suggest that automated transaction machines which are operative to dispense cash withdrawn from banking accounts are also operative to digitally sign electronic documents visually displayed by the automated transaction machines. It is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 10 should be withdrawn.

Claim 11

Claim 11 depends from claim 1. Claim 11 recites that in step (a) the accounts correspond to digital safe deposit accounts and in step (c) the cards correspond to digital safe deposit account cards. The Action references various portions of Muftic which Applicants assume the Office believes to be relevant to claim 11. For example the Action references Column 9, lines 34-38 of Muftic which discloses archiving server(s) 160 that may provide a repository for legal and contractual transactions. In addition the Action discusses Column 12, lines 53-58 of Muftic which discloses that "Typically, a user's public key would be stored in the server at the time the account was set up for the application server and would be accessible for checking by the system." The Action also references Column 19, lines 1-21 which discusses a way to perform a transaction regarding the sale of shares of stock. The described sale includes the sellers digitally signing a copy of the stock certificate together with an assignment of ownership.

It is unclear how these different portions of Muftic disclose or suggest the features recited in Applicants' claim 11. Although Muftic discloses an archiving server and an application server, nowhere does Muftic disclose or suggest producing digital safe deposit cards with machine readable indicia corresponding to digital safe deposit accounts.

The Action also refers to online repositories offered by "Yahoo, Hotmail, or ISPs" to support the rejection. However, as discussed previously an assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Applicants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

In addition, even if it were possible to modify Muftic to include an online repository, the presence of an online repository in Muftic still does not disclose or suggest the features recited in claim 11. For example, nowhere does Muftic (or Muftic in view of the unsupported assertions about Yahoo, Hotmail, or ISPs) disclose or suggest producing cards with a first visible digital signature service source indicator mark indicia thereon and **machine readable data corresponding to digital safe deposit accounts**. Further nowhere does Muftic disclose or suggest producing cards with a first visible digital signature service source indicator mark indicia thereon, which cards correspond to **digital safe deposit account cards**.

It is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 11 should be withdrawn.

The New Claims

Claim 12 is an independent method which recites subject matter found in original claims 1, 2, and 9. Claim 12 recites providing cards which include a visible digital signature service source indicator mark thereon, and providing on each of a plurality of ATMs a visible digital signature service source indicator mark which visually corresponds to the visible digital signature service source indicator mark on the card. Claim 12 also recites operating one of the plurality of cash dispensing ATMs to read data on a card presented by a customer and to output a visual representation of an electronic document to be visually displayed through at least one output device in operative connection with the ATM. Claim 12 further recites causing the displayed electronic document to be digitally signed responsive to communication with a digital signature service server in operative connection with the plurality of ATMs. Claim 12 further recites the communication includes communicating to the digital signature service server, the at least one

account identifying number corresponding to data read from the card by the ATM. Nothing in the cited art discloses or suggests these features.

Claim 13 depends from claim 12. Claim 13 generally corresponds to original claim 6 and recites that each account number corresponds to a financial account identifying number, and that each card is at least one of a credit card, debit card and a bank card.

Claim 14 depends from claim 12 and recites subject matter found in original claim 5. Claim 14 recites prior to (c) generating a private key and a corresponding public key for each of the plurality of individual customers. Claim 14 further recites prior to (c) storing the private keys in at least one data store, wherein each private key is stored in correlated relation with the financial account identifying number for the respective individual customer. In addition claim 14 recites that (c) includes determining through operation of the digital signature service server, a private key responsive to data in the data store and the financial account number communicated in (c). Claim 14 further recites causing a digital signature to be generated for signing the electronic document responsive to the determined private key.

Claim 15 depends from claim 14 and recites subject matter found in original claim 4. Claim 15 recites producing at least one digital certificate for each of the plurality of individual customers, and that each digital certificate includes the respective public key generated in (d) for the respective customer. Claim 15 also recites that each public key is adapted to be used to authenticate a digital signature generated for an electronic document using a respective corresponding private key.

Claim 16 depends from claim 12 and generally corresponds to features recited in original claim 8.

Claim 17 is an independent method claim which recites subject matter found in original claims 1 and 5. Claim 17 recites in (a) generating a plurality of private keys and a corresponding public key for each of a plurality of private keys. Claim 17 further recites in (b) storing data corresponding to each private key in at least one data store, such that the data corresponding to each private key is stored in correlated relation with data representative of at least one of an individual and a financial account identifying number associated with a respective individual. Claim 17 also recites in (c) providing at least one card to each of the plurality of individuals, such that each card includes machine readable data corresponding to at least one of an individual and a financial account identifying number associated with the respective individual. In addition claim 17 recites in (d) operating one of a plurality of automated transaction machines to read data from a card presented by an individual to the machine. Claim 17 further recites displaying a visual representation of an electronic document through at least one output device in operative connection with the automated transaction machine. Claim 17 further recites causing the electronic document to be digitally signed using a private key retrieved from the at least one data store responsive to data read from the card through communication with at least one remote server. Wherein the remote server is adapted to communicate with each of the plurality of automated transaction machines.

Claim 18 depends from claim 17 and recites subject matter found in original claims 1 and 2. Claim 18 recites that each card provided in (c) includes a visible digital signature service source indicator mark thereon. Claim 18 further recites including on each of the plurality of automated transaction machines a visible digital signature service source indicator mark, which visually corresponds to the visible digital signature service source indicator mark on the cards.

Claim 19 depends from claim 17 and generally corresponds to features recited in original claim 9.

Claim 20 depends from claim 17. Claim 20 generally corresponds to features recited in original claim 6 and recites that each card provided is at least one of a credit card, debit card and a bank card.

None of the cited references alone or in combination discloses or suggests the features, relationships and steps that are specifically recited in the new claims 12-20. These claims recite features, relationships and steps recited in the original claims, and are allowable for at least the same reasons. As nothing in the cited art discloses or suggests the features, relationships and steps that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

Additional Claim Fees

No fee is due with the submission of this Response. However, for any other fees due associated with the prosecution of this Application, please charge Deposit Account No. 09-0428 of Diebold Self-Service Systems.

Conclusion

Each of Applicants' pending claims specifically recites features, relationships and steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art

so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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